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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,312	11/17/2003	Edwin S. Grosvenor	128033.0101	5119

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EXAMINER

MCCORMICK, GABRIELLE A

ART UNIT	PAPER NUMBER
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3629

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/715,312	GROSVENOR, EDWIN S.	
	Examiner	Art Unit	
	Gabrielle McCormick	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/9/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on November 17, 2003.
2. Claims 1-39 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on February 9, 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 32-37 are rejected as being directed to non-statutory subject matter. Claim 32 is a method claim that recites process steps that are not tied to a particular machine. Based on recent Federal Circuit decision (see *In re Bilski*), an applicant may show that a process claim satisfies 35 USC 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. (See Benson, 409 U.S. at 70). First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. (See Benson, 409 U.S. at 71-72). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. (See Flook, 437 U.S. at 590).
6. Claim 32 does not recite the use of any machine implementation, rather, it recites method steps that can be implemented by a human being.

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7. Because the applicable test to determine whether a claim is drawn to a patent-eligible process under 35 USC 101 is the machine-or-transformation test set forth by the Supreme Court, claim 32 fails that test and is therefore rejected under 35 USC 101. Claims 33-37 are rejected through dependency from claim 32.
8. Claims 38 and 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims comprise “a computer-readable medium operatively coupled to the processor”. The specification at P[0052] states, “program instructions may be stored on a computer readable medium such as...a communications signal or carrier wave.” A “signal” does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (i.e., process, machine, manufacture, or composition of matter).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
10. **Claims 1-9, 12-16, 18-20, 23-29, 32-36 and 38-39** are rejected under 35 U.S.C. 102(b) as being anticipated by Stirpe et al. (US Pub. No. 2002/0087496, hereinafter referred to as “Stirpe”).
11. **Claims 1 and 38:** Stirpe discloses a method and system (Fig. 1 and P[0075]) for
 - *cataloguing educational audiovisual content of a meeting of a first organization from a first content provider;* (P[0086]: knowledge components are tagged and integrated with ontologies to improve the ability for matching content to users and P[0126-0127] and Fig. 11: knowledge components are stored using subdirectories, sub-institution names, further subdirectories under the sub-institution, various sessions for a knowledge component and finally the knowledge component file.)

- *receiving membership information for a person seeking to access at least a portion of the educational audiovisual content; (P[0091]: user registers)*
- *verifying a membership status of the person based on the membership information; (P[0122]: user is authenticated using a password; P[0121]: access to content is dependent on membership status)*
- *determining a fee based on at least one of a level of service requested by the person and the membership status of the person; (P[0146]; [0154] and [0157-0158])*
- *verifying payment of the fee by the person; (P[0147]: users pay by credit card)*
- *transmitting a streamed video of the educational audiovisual content to the person; ([0003]:*
- *distributing royalty payments. (P[0147])*

12. Claims 32 and 39: Stirpe discloses a method and system (Fig. 1; P[0075]) for

- *receiving educational audiovisual content from a separate first entity; (P[0003])*
- *permitting access to the educational audiovisual content to one or more persons for a fee; (P[0003])*
- *charging the fee to a person who accesses at least a portion of the educational audiovisual content; (P[0147])*
- *receiving payment of the fee. (P[0147])*

13. Claims 2-3: Stirpe discloses *receiving the educational audiovisual content of a meeting of the first organization from the first content provider. (P[0003] and P[0164])*

14. Claim 4: Stirpe discloses *receiving information regarding educational audiovisual content; organizing the educational audiovisual content into groups based on the content provider; organizing each group of educational audiovisual content into sub-groups, wherein each sub-group corresponds to a conference operated by the corresponding content provider; organizing each sub-group into tracks, wherein each track corresponds to related sessions at a corresponding conference; and organizing each track into elements, wherein each element corresponds to a session of the corresponding track. (P[0164]: conference providers are analogous to institutions and P[0086]: knowledge components are tagged and integrated with*

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ontologies to improve the ability for matching content to users and P[0126-0127] and Fig. 11: knowledge components are stored using subdirectories, sub-institution names, further subdirectories under the sub-institution, various sessions (i.e., tracks) for a knowledge component and finally the knowledge component file (i.e., the element.)

15. **Claims 5 and 6:** Stirpe discloses that the user selects the knowledge component (i.e., element) to purchase after searching via criteria based (P[0090-0091]). It is inherent that the level of service and therefore the fee is based on the particular search results and that the selected component fee is thus a session or session track of a meeting.
16. **Claim 7:** Stirpe discloses assigning metadata to subject matter (title) and transmission-related information (start data, end date, frequency) and the content provider (offering institution). (P[0019]).
17. **Claims 8, 9, 12, 19, 20, 23 and 34:** Stirpe discloses that a person can be a member of either a first organization or a second. (P[0080], P[0130] and [0121]: institutions each have their own members and access is limited based on institution memberships, thus membership is verified. Containers are understood to be databases.).
18. **Claims 13 and 24:** Stirpe discloses passwords. (P[0122])
19. **Claim 14:** Stirpe discloses processing a credit card transaction. (P[0147]).
20. **Claims 15, 16, 18, 25, 33, 35 and 36:** Stirpe discloses that recipients pay for knowledge components to the knowledge exchange service provider (first provider) who collects a percentage (royalty) and provides the offering institution (first and second organizations/entities) or expert (presenter) any surplus (a royalty). (P[0146]).
21. **Claims 26, 27 and 29:** Stirpe discloses providing content live, archived and self-paced in either single or multiple sessions over the Internet. (P[0077]). Self-paced is provided at time person requests, whereas multiple sessions are provided at a later requested time.
22. **Claim 28:** Stirpe discloses providing a trainer's CV or resume in a web page. (P[0143-0144]).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. **Claims 10-11, 17, 21-22, 30-31 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirpe et al. (US Pub. No. 2002/0087496, hereinafter referred to as "Stirpe").
25. **Claims 10-11, and 21-22:** Stirpe discloses determining whether a person is a member of either a first or second organization (P[0080], P[0130] and [0121]) but does not disclose an active member or a level of membership.
26. However, the Examiner takes **Official Notice** that it is old and well known to determine whether someone is an active member or the level of membership. In the military, varying benefits are accorded to active-duty vs. retired members, further rank also plays a role in determining a benefit level. For example, DOD operates vacation facilities across the world where accessibility is prioritized by activity level and payment for services is dependent on rank.
27. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included active membership and a level of membership, in the system of Stirpe for the motivation of providing further enhancements to the various billing models disclosed.
28. **Claims 17 and 37:** Stirpe discloses paying fees to the institutions providing the content and discloses that conference providers are analogous to institutions in the knowledge commerce model. (P[0164]). Therefore, it is inherent that the conference provider would be paid a fee. Further it is obvious that often conference providers are copyright holders of the information they present.
29. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included paying fees to copyright holders, in the system of Stirpe for the motivation of

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acknowledging the common link between a conference presenter and the material presented and thus providing the appropriate fee for the use of the material.

- 30. Claims 30 and 31:** Stirpe discloses the Internet. It is obvious to expand Stirpe to include transmission over either a cable or satellite network as those are old and well known means of transmitting information either over the Internet or as an alternate means.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629